

## REMARKS

### **(1) Response to the Notice of Non-compliant Amendment**

The amendment submitted in response to the Office Action of October 5, 2006 was rejected as being non-compliant under 37 CFR 1.126 because the amendment did not properly designate claim 68 as "Currently Amended." In response to the Notice of Non-compliant amendment, applicants have corrected the status identifier of claim 68 to state "Currently Amended" rather than "Previously Presented."

### **(2) Response to the Office Action of June 14, 2005**

Claims 36-68, 70-73 and 84 are pending in this application, with claims 36, 47, 68 and 84 being independent. Claims 36, 47, 68, 72 and 84 have been amended. Claims 69, 74, and 81-83 have been canceled. No new matter has been added.

Applicants note that the amendment submitted in response to the Office Action of March 13, 2006 included an amendment to claim 36 that inadvertently omitted the term "user" in the "determining television programming" limitation. Applicants did not intend this term, which was included in the previously pending claims, to be omitted. Accordingly, the amendment submitted with these remarks once again includes the term "user" in the "determining television programming" limitation of claim 36.

All of the pending claims have been rejected as being unpatentable over Shah (U.S. Publication No. US 2001/0013050) in view of DeWeese (U.S. Publication No. US 2005/0262542).

Independent claims 36 and 47, as amended, each recite, among other features, "determining/determine television programming selected for viewing by a network user", "selecting/select, based upon the determined television programming, an initial buddy list that includes two or more initial buddy groups", and "displaying/display the two or more initial buddy groups to the network user by displaying the initial buddy list to the network user on an instant messaging user interface, wherein each of the displayed two or more initial buddy groups comprises online presence information for its members." Applicants request reconsideration and

withdrawal of the rejection of claims 36 and 47, and their dependent claims, because neither Shah, DeWeese, nor any proper combination of the two describes or suggests the recited selection of a buddy list having two or more buddy groups based upon a determination of television programming selected for viewing by a network user and subsequently displaying the two or more buddy groups in the selected buddy list in an instant messaging user interface.

Shah describes a system that enables a user to communicate with other users through use of an aggregated contact list or address book that includes contacts selected by the user from various different messaging services. Shah refers to the address book as a "buddy list." A user is able to organize the address book by placing user contacts in different groups, such as an MSN Messenger service group and a Personal Desktop Portal Development Team Group. See paragraphs 0118, 0123 and 0126. See Fig. 24. The user is able to view the user contacts in each group by manually selecting the group in the address book. See paragraph 0123 and 0126. When the user selects a group, the user contacts of the selected group are displayed in a list. See Fig. 25 and Fig. 28. The user contacts in the list may be displayed along with a communication availability status for each user corresponding to each contact. See paragraphs 0126 and 0127. The user may then select a user contact in the displayed list to thereby initiate communications with the selected user via various communication methods, including e-mail, whiteboard, chat, and instant messenger. See paragraphs 0124 and 0127.

Notably, selection of the different groups in the address book, which the Examiner apparently equates to the recited buddy list and buddy groups, is not done based on a determination of television programming selected for viewing by a network user. Rather, selection of the different groups in the address book is achieved through manual selection of the specific groups by the user.

Deweese also fails to describe or suggest selection of a buddy list having two or more buddy groups based upon a determination of television programming selected for viewing by a network user. Deweese describes a television chat system that enables a user to define an address book that may be used to chat with other users. The address book may include a list of identities of individuals and groups of individuals. See paragraph 0087. The groups may

include groups of individuals that are interested in a particular TV program, such as, for example, a Seinfeld Fan Club group. See paragraph 0088. Deweese describes a set top box application that presents a pop-up option on a television screen to a user that enables the user to send a chat request to individuals in a group in the address book when the user is watching a television program related to the group (e.g., Seinfeld). See paragraph 0088.

Accordingly, Deweese contemplates automatically selecting a list of individuals in a group of an address book based on a television program being viewed by a user to enable a user to send a chat request to the individuals in the group. Deweese, however, does not describe or suggest that the pop-up option displays the list of individuals to the user, nor does Deweese describe or suggest that the list includes two or more groups within it. Deweese also does not describe or suggest that the list includes online presence information. Rather, Deweese simply states that the pop-up option enables a user to send a chat request to the individuals in the list. See paragraph 088 ("If desired, the set top box application may present a pop-up option on the television screen to send a chat request to the individuals in a list in the address book when the user is watching a related television program (e.g., Seinfeld).") Therefore, Deweese does not describe or suggest selection of a buddy list that includes two or more buddy groups based on a determination of television programming selected for viewing by a user and subsequently displaying the two or more buddy groups in the selected buddy list.

Applicants also submit that a person of ordinary skill in the art would not be motivated to combine the teachings of Shah and Deweese in the manner contemplated by the Examiner. The Examiner states:

It would have been obvious to one of ordinary skill in the art to combine the teachings of Shah with DeWeese et al in order to enable television-program based chatting wherein user's buddy lists are based on television programs; because just as a user may choose to chat in a particular chat room where those present are discussing a particular program, the user may also want to instant message a member in their predefined buddy list/group of users who also shares particular television programming interests as well; therefore allowing the user to communicate in real-time with selected co-users that are currently online for immediate discussion of the selected television programs.

See page 4 of Office Action. Other than the impermissible hindsight gleaned through a reading of the present application, no motivation exists for a combination of the features of Shah

and Deweese to meet the above-recited features. Applicants do not dispute that a user would be benefited by attempting to achieve the features and functions articulated by the present specification through a previously-unrealized combination of features disclosed by the references. However, applicants appropriately question the motivation leading to such a previously-unrealized combination. While the features and functions achieved through the present application may appear pedestrian following a review of the application, they were neither known nor suggested prior to their articulation in the present specification.

Moreover, a review of either prior art reference would leave a reader without any motivation to provide different buddy list groups, or different buddy lists for that matter, based on a television program presently being selected for viewing. Rather, those referencing the art would be motivated to follow the teachings of those references, providing buddy lists without regard for television programming selection as disclosed by Shah, and merely selecting a group of potential chat participants without regard for buddy lists in accordance with the teachings of Deweese.

The very notion that these references would be combined to achieve different buddy list groups for different user selected television programming results only from a reading of the present disclosure, which is, by definition, impermissible hindsight reconstruction.

For at least the above reasons, applicants request reconsideration and withdrawal of the rejection of claims 36 and 47, and their dependent claims.

Independent claim 68, as amended, recites, among other features, “determining television programming selected for viewing by the network user”, “triggering, based on the determined television programming, selection of a buddy list among the first buddy list and the second buddy list, the buddy list including two or more buddy groups” and “displaying the two or more buddy groups to the network user by displaying the selected buddy list to the network user on an instant messaging user interface, wherein each of the displayed two or more buddy groups comprises online presence information for its members.” For at least the reasons discussed above, applicants request reconsideration and withdrawal of the rejection of claim 68 and its

dependent claims because neither Shah, Deweese, nor any proper combination of the two describes or suggests the above-recited features.

Independent claim 84, as amended, recites “determining television programming selected for viewing by a network user”, “accessing two or more lists of online identities for which online presence is monitored, each of the lists comprising one or more groups that each include one or more online identities specified by the network user” “selecting, based upon the determined television programming, a list from among the two or more lists, the list including two or more groups” and “displaying the two or more groups to the network user by displaying the selected list to the network user on an instant messaging user interface, wherein each of the displayed groups comprises online presence information for the online identities included within it”. For at least the reasons discussed above, applicants request reconsideration and withdrawal of the rejection of claim 84 because neither Shah, Deweese, nor any proper combination of the two describes or suggests the above-recited features.

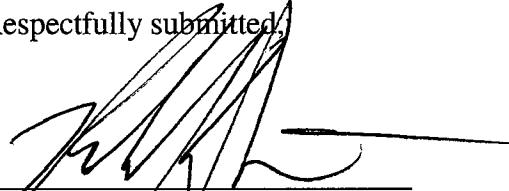
Applicants do not acquiesce in the Examiner's characterizations of the art. For brevity and to advance prosecution, however, applicants may have not addressed all characterizations of the art and reserve the right to do so in further prosecution of this or a subsequent application. The absence of an explicit response by the applicants to any of the Examiner's positions does not constitute a concession of the Examiner's positions. The fact that applicants' comments have focused on particular arguments does not constitute a concession that there are not other arguments for patentability of the claims. All of the dependent claims are patentable for at least the reasons given with respect to the claims on which they depend.

Applicant : Carlos Silva et al.  
Serial No. : 09/475,391  
Filed : December 30, 1999  
Page : 15 of 15

Attorney's Docket No.: 06975-048001 / AOLT V 07

Applicants submit that all claims are in condition for allowance. Although Applicants believe no fee is due, please use Deposit Account No. 06-1050 for any charges or credits that may be necessary.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Roberto J. Devoto', written over a horizontal line.

Roberto J. Devoto  
Reg. No. 55,108

Date: April 5, 2007

Fish & Richardson P.C.  
1425 K Street, N.W.  
11th Floor  
Washington, DC 20005-3500  
Telephone: (202) 783-5070  
Facsimile: (202) 783-2331